

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner

Case IPR2017-02202
Patent No. 8,239,852 B2

**PETITIONER'S REQUEST FOR REHEARING
UNDER 37 C.F.R. § 42.71(D)**

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Petitioner Apple Inc. respectfully requests rehearing of the Board’s Decision Denying Institution of *Inter Partes* Review (“Decision,” Paper 8). The Board’s Decision was based on a misinterpretation of the claim language of U.S. Patent No. 8,239,852 (the “’852 Patent”) and a misapprehension of Petitioner’s arguments.

In its Decision, the Board implicitly construed the claim limitation “performs physical device recognition ... to determine machine parameters” in a way that excludes two types of data explicitly recited by the ’852 Patent’s claims and described in the specification. Specifically, the ’852 Patent’s claims explicitly state that the term “machine parameters” includes both “account information for a user of a client device” and “features of software that the user of the client device is entitled to use.” Ex. 1101, Claims 1, 18. The Board acknowledged that the prior art presented in the Petition discloses acquiring “account information” and “features of software.” Decision at 18. But the Board, nonetheless, found that this data—the same data expressly identified by the claims as “machine parameters”—do not qualify as “machine parameters” under the Board’s implicit construction of that limitation. *Id.* Instead, the Board mistakenly construed the claims to require this data to be “present in” some other, undefined machine parameter. *Id.* This incorrect claim construction also led the Board to construe “physical device

recognition” in a manner contrary to its description in the ’852 Patent specification. Because the Board’s interpretation of the claim language excludes the examples recited in the claims and described in the specification, it is legally erroneous. *See Westerngeco LLC v. PGS Geophysical*, Case IPR2015-00313, Paper 45 at 4-11 (P.T.A.B. Feb. 3, 2017) (granting request for rehearing because the original decision rested on an incorrect implicit construction of a claim term).

Moreover, the Board’s decision is also unsupported by the evidence of record. The Board’s implicit construction appears to require each “machine parameter” to uniquely identify a computer. Decision at 18-19. But there is no evidence in the record supporting such a requirement. Rather, as demonstrated in the Petition, the “machine parameters” term is used by the ’852 Patent to describe different types of hardware-, software-, and user-related data. The ’852 Patent recognizes that each “machine parameter” need not be unique, and it describes using a combination of multiple parameters to uniquely identify a machine. Thus, the Board’s denial of institution is not supported by the record evidence.

Under the proper interpretation of the claim language, the prior art presented in the Petition discloses the “performs physical device recognition ... to determine machine parameters” claim limitation. Because the Decision rests on an incorrect implicit construction of a claim term, Petitioner respectfully requests that the Board modify its Decision and institute review on all challenged claims.

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